

ATTY. DOCKET NO.: P67083US0

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of: :  
: Marcus HARTMANN et al. :  
: Serial No.: 09/914,870 :  
: Filed: September 4, 2001 :  
: For: B-HEXOSAMINIDASE AND A DNA SEQUENCE CODING IT OBTAINED FROM :  
CILIATES AND USE THEREOF :  
METHOD :

**RESPONSE TO NOTICE TO COMPLY WITH SEQUENCE RULES**

Commissioner of Patents  
Box PCT  
Washington, D.C. 20231

Sir:

In accordance with the Notice to Comply with sequence rules 37 CFR 1.821 – 1.825, a copy of which is attached, hereto, applicant submits, herewith:

- (1) Computer Readable Form (CRF) of Sequence Listing; and
- (2) Substitute paper copy of Sequence Listing.

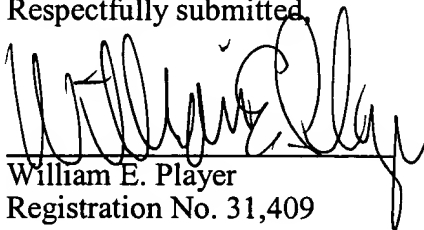
The content of the computer readable form and the paper copy are the same and, where applicable, include no new matter, as required by 37 CFR § 1.821(e), § 1.821(f), § 1.821(g), § 1.825(b), or 1.825(d).

An amendment entering the Sequence Listing is filed, concurrently herewith.

Favorable action is requested.

Respectfully submitted,

By

  
William E. Player  
Registration No. 31,409

JACOBSON HOLMAN PLLC  
400 Seventh Street, N.W.  
Washington, D.C. 20004  
Telephone: (202) 638-6666  
Atty. Docket No.: P67083US0  
Date: January 28, 2002  
WEP:rdt

11-1-01  
TC 11-1-01

christ

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Page 1 of 2

☒ Commissioner For Patents, Box PCT, United States Patent and Trademark Office, Washington, D.C. 20231, www.uspto.gov

U.S. APPLICATION NUMBER NO.	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
09/914,870	Marcus HARTMANN	P67083US0

00136  
JACOBSON HOLMAN PLLC  
400 SEVENTH STREET N.W.  
SUITE 600  
WASHINGTON, DC 20004

**COPY**

JACOBSON HOLMAN PLLC  
Response Due On Or Before  
12 / 26 / 01  
Month Day Year

INTERNATIONAL APPLICATION NO.	
PCT/EP00/01853	
LA. FILING DATE	PRIORITY DATE
03/03/2000	03/04/1999

CONFIRMATION NO. 4106  
371 FORMALITIES LETTER

  
\*OC000000006962386\*

Date Mailed: 10/26/2001

### NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)

The following items have been submitted by the applicant or the IB to the United States Patent and Trademark Office as an Elected Office (37 CFR 1.495):

- U.S. Basic National Fees
- Indication of Small Entity Status
- Priority Document
- Biochemical Sequence Listing
- Copy of IPE Report
- Copy of the International Application
- Copy of the International Search Report
- Preliminary Amendments
- Request for Immediate Examination

The following items **MUST** be furnished within the period set forth below in order to complete the requirements for acceptance under 35 U.S.C. 371:

- Oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date.
- The nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 CFR 1.821-1.825 for the following reason(s):
  - A copy of the "Sequence Listing" in computer readable form has not been submitted as required by 37 CFR 1.821(e).
  - APPLICANT MUST PROVIDE:
    - An initial or substitute computer readable form (CRF) of the "Sequence Listing."
    - A statement that the contents of the paper or compact disc and the computer readable form are the same and, where applicable, include no new matter, as required by 37 CFR 1.821(e), 1.821(f), 1.821(g), 1.825(b) or 1.825(d).

- For questions regarding compliance to 37 CFR 1.821-1.825 requirements, please contact:
  - For Rules Interpretation, call (703) 308-4216
  - To Purchase PatentIn Software, call (703) 306-2600
  - For PatentIn Software Program Help, call (703) 306-4119 or e-mail at patin21help@uspto.gov or patin3help@uspto.gov

**ALL OF THE ITEMS SET FORTH ABOVE MUST BE SUBMITTED WITHIN TWO (2) MONTH FROM THE DATE OF THIS NOTICE OR BY 22 or 32 MONTHS (where 37 CFR 1.495 applies) FROM THE PRIORITY DATE FOR THE APPLICATION, WHICHEVER IS LATER. FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.**

The time period set above may be extended by filing a petition and fee for extension of time under the provisions of 37 CFR 1.136(a).

Applicant is reminded that any communications to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above (37 CFR 1.5)

FRANCINE YOUNG

Telephone: (703) 305-3662

**PART 1 - ATTORNEY/APPLICANT COPY**

U.S. APPLICATION NUMBER NO.	INTERNATIONAL APPLICATION NO.	ATTY. DOCKET NO.
09/914,870	PCT/EP00/01853	P67083US0



JC10 Rec'd PCT/PTO 28 JAN 2002

Atty. Docket No. P67083US0

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of: Marcus HARTMANN et al.

Serial No.: 09/914,870

Filed: September 4, 2001

For:  $\beta$ -HEXOSAMINIDASE AND A DNA SEQUENCE CODING IT OBTAINED FROM CILIATES AND USE THEREOF

TRANSMITTAL

Commissioner of Patents  
Box PCT  
Washington, D.C. 20231

Sir:

Transmitted herewith are:

- Copy of Notification of Missing Requirements mailed October 26, 2001.
- Declaration of inventors under 37 CFR 1.497.
- Response to Notice to Comply with Sequence Rules, including Sequence Listing, Amendment, and computer diskette.
- Petition for Extension of Time.
- Statement Under 37 CFR 1.497(d)(1).
- Consent of Assignee Under 37 CFR 1.497(d)(3).
- Check in the amount of \$185 for: extension of time; processing fee as required under 37 CFR 1.497(d)(2).

If a Petition for Extension of Time is necessary and the Petition and/or the check is not enclosed, this will act as the Petition and applicant herewith petitions the Commissioner to extend the time for response and charge any fees necessary under 37 CFR 1.17 (a)-(d) to Deposit Account No. 06-1358. The Commissioner is also authorized to charge payment of any other additional fees associated with this communication or credit any overpayment to Deposit Account No. 06-1358.

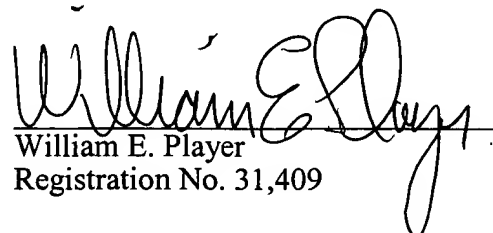
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JACOBSON-HOLMAN PLLC  
400 Seventh Street, N. W.  
Washington, D.C. 20004-2201  
Date: January 28, 2002  
WEP:rdt  
R:\HOME\thomas\2002\January\P67083trn.wpd

By:

  
William E. Player  
Registration No. 31,409

Atty. Docket No. P67083US0

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Marcus HARTMANN et al.

Serial No.: 09/914,870

Filed: September 4, 2001

For:  $\beta$ -HEXOSAMINIDASE AND A DNA SEQUENCE CODING IT OBTAINED FROM  
CILIATES AND USE THEREOF

STATEMENT UNDER 37 CFR 1.497(d)(1)

Commissioner of Patents  
Washington, D.C. 20231

Sir:

Peter VOHLE, a citizen of Germany, states that any error in inventorship in international application PCT/EP00/01853, filed March 3, 2000, occurred without deceptive intention on his part.

10.01.2002

Date

  
Peter VOHLE

## BEST AVAILABLE COPY

Atty. Docket No. P67083US0

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Via Facsimile

Marcus HARTMANN et al.

703-305-3230

Serial No.: 09/914,870

Filed: September 4, 2001

For:  $\beta$ -HEXOSAMINIDASE AND A DNA SEQUENCE CODING IT OBTAINED FROM  
CILIATES AND USE THEREOF

## TRANSMITTAL

Commissioner For Patents  
Box PCT  
United States Patent and Trademark Office  
Washington, D.C. 20231

Sir:

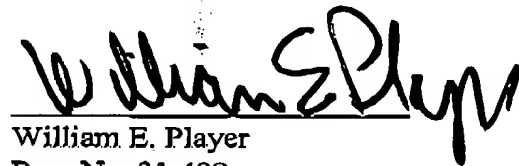
Transmitted herewith via facsimile are Response to the Notification of Defective Response,  
together with a copy of the Notification, mailed May 14, 2002..

Should any Government fees be required in conjunction with the transmitted Response,  
please charge the fees necessary to Deposit Account No. 06-1358. Petition is made for any extension  
of time necessary in conjunction with this response is.

Respectfully submitted,

JACOBSON-HOLMAN PLLC

By:

  
William E. Player  
Reg. No. 31,409400 Seventh Street, N.W.  
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Washington, D.C. 20004  
Tel.: (202) 638-6666  
Atty. Dkt. No.: P67083US0  
Date: June 14, 2002  
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WEP



UNITED STATES PATENT AND TRADEMARK OFFICE

 Commissioner for Patents, Box-PCT  
 United States Patent and Trademark Office  
 Washington, D.C. 20231  
 www.uspto.gov

U.S. APPLICATION NUMBER NO.	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
09/914,870	Marcus HARTMANN	P67083USO

 00136  
 JACOBSON HOLMAN PLLC  
 400 SEVENTH STREET N.W.  
 SUITE 600  
 WASHINGTON, DC 20004

COPY

INTERNATIONAL APPLICATION NO.	
PCT/EP00/01853	
LA. FILING DATE	PRIORITY DATE
03/03/2000	03/04/1999

 JACOBSON HOLMAN PLLC  
 Response Due On Or Before  
 6 / 14 / 02  
 Month Day Year

 CONFIRMATION NO. 4106  
 371 FORMALITIES LETTER

\*OC00000008097553\*

Date Mailed: 05/14/2002

## NOTIFICATION OF DEFECTIVE RESPONSE

The following items have been submitted by the applicant or the IB to the United States Patent and Trademark Office as an Elected Office (37 CFR 1.495):

- U.S. Basic National Fee
- Indication of Small Entity Status
- Priority Document
- Assignee Statement
- Biochemical Sequence Diskette
- Biochemical Sequence Listing
- Copy of IPE Report
- Copy of the International Application
- Copy of the International Search Report
- Oath or Declaration
- Preliminary Amendments
- Request for Immediate Examination

The following items **MUST** be furnished within the period set forth below in order to complete the requirements for acceptance under 35 U.S.C. 371:

- Oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. The current oath or declaration does not comply with 37 CFR 1.497(a) and (b) in that it:
  - Is not executed by inventor Vohle

Applicant is required to complete the response within a time limit of **ONE MONTH** from the date of this Notification or within the time remaining in the response set forth in the Notification of Missing Requirements, whichever is the longer. No extension of this time limit may be granted under 37 CFR 1.136, but the period for response set in the Notification of Missing Requirements may be extended under 37 CFR 1.136(a).

Applicant is reminded that any communications to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above (37 CFR 1.5)

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*A copy of this notice **MUST** be returned with the response.*

FRANCINE YOUNG

Telephone: (703) 305-3662

PART 1 - ATTORNEY/APPLICANT COPY

U.S. APPLICATION NUMBER NO.	INTERNATIONAL APPLICATION NO.	ATTY. DOCKET NO.
09/914,870	PCT/EP00/01853	P67083US0

FORM PCT/DO/EO/916 (371 Formalities Notice)

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Atty. Docket No. P67083US0

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re the Application of: Marcus HARTMANN et al.

Serial No.: 09/914,870

Filed: September 4, 2001

For:  $\beta$ -HEXOSAMINIDASE AND A DNA SEQUENCE CODING IT OBTAINED FROM  
CILIATES AND USE THEREOF**RESPONSE TO NOTIFICATION OF DEFECTIVE RESPONSE**Commissioner For Patents  
Box PCT  
United States Patent and Trademark Office  
Washington, D.C. 20231

Sir:

According to the Notification of Defective Response mailed May 14, 2002 (copy submitted herewith), the inventorship declaration of record allegedly fails to comply with 37 CFR 1.497(a) "in that it: Is not executed by inventor Vohle." As a result of the allegation, the Notification requires a new oath or declaration of inventorship be furnished to the PTO. The requirement for a new oath or declaration is improper and unnecessary.

A new oath or declaration need not be furnished because the inventorship declaration of record, in fact, *does comply* with 37 CFR 1.497(a), allegations in the Notification to the contrary notwithstanding.

In the instant national stage application, the inventorship declaration of record does not name Peter Vohle, who is named as an inventor in the international application, i.e., PCT/EP00/01853, filed March 3, 2000. This situation is governed by 37 CFR 1.497(d), which reads in pertinent part (*emphasis added*):

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Atty. Docket No. P67083US0  
Serial No.: 09/914,870

§1.497 Oath or declaration under 35 U.S.C.

371(c)(4) . . .

(d) If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section *names an inventive entity different from the inventive entity set forth in the international application* . . . applicant must submit:

(1) A statement from each person being added as an inventor and from *each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;*

(2) The processing fee set forth in §1.17(i); and

(3) If an assignment has been executed by any of the original named inventors, the written consent of the assignee . . . .

In accordance with 37 CFR 1.497(d), besides the inventorship declaration of record, the papers filed January 28, 2002, in response to the notification of missing requirements mailed October 26, 2001, included:

- 1) "Statement Under 37 CFR 1.497(d)(1)," executed by Peter Vohle, which reads (*emphasis added*):

Peter VOHLE, a citizen of Germany, states that *any error in inventorship in international application PCT/EP00/01853, filed March 3, 2000, occurred without deceptive intention on his part;*

- 2) A check covering *the processing fee set forth in §1.17(i); and*
- 3) "Consent Of Assignee Under 37 CFR 1.497(d)(3)," executed by assignee Cilian AG, which reads:

Cilian AG, a corporation of Germany, assignee of the instant application . . . consents in accordance with 37 CFR 1.497(d)(3) to

**BEST AVAILABLE COPY** Atty. Docket No. P67083US0  
Serial No.: 09/914,870

the filing, herewith, of the inventorship declaration under 35 USC 371(c)(4) and 37 CFR 1.497, which inventorship declaration names an inventive entity different from the inventive entity set forth in international application PCT/EP00/01853, filed March 3, 2000.

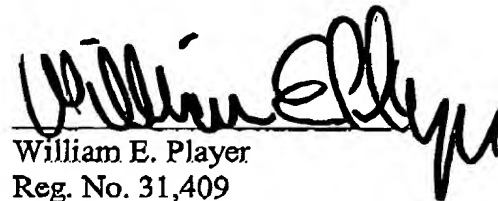
Accordingly, compliance with 37 CFR 1.497(a) is met by the inventorship declaration of record, which "names an inventive entity different from the inventive entity set forth in the international application," since the declaration was filed together with the papers and fee required in accordance with 37 CFR 1.497(d).

Favorable action is requested.

Respectfully submitted,

JACOBSON-HOLMAN PLLC

By:

  
William E. Player  
Reg. No. 31,409

400 Seventh Street, N.W.  
The Jenifer Building  
Washington, D.C. 20004  
Tel.: (202) 638-6666  
Atty. Dkt. No.: P67083US0  
Date: June 14, 2002

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\*\*\* RX REPORT \*\*\*  
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RECEPTION OK

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USAGE T	02'26	
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RESULT	OK	